APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,007	01/18/2001	Tracy J. Evans	10001946-1	7974

7590   02/09/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER
INGBERG, TODD D

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)	
Office Action Summary		09/766,007	EVANS ET AL.	
		Examiner	Art Unit	
		Todd Ingberg	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _21 May 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a)☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2_.

4)☐ Interview Summary (PTO-413) Paper No(s). _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 11-03)   Office Action Summary   Part of Paper No. 3

DETAILED ACTION

Claims 1 – 20 have been examined.

Information Disclosure Statement

1.   The information disclosure statement on how Dell performs installing software on new

computers; filed May 21, 2001 has been considered.

Specification

2.   The abstract of the disclosure is objected to because it is greater than 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

4.   Claims 1, 12, 15 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The limitation storing a user interface as claimed is indefinite.

The interpretation is that a file is stored. An explanation is needed. Is this the HP screen that is

displayed on the screen. What displays the "User Interface". It is possible the definition for the

record will distinguish the invention.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1- 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewlett-

Packard's commercial product OpenView™ as documented in the 1995 publication by Nathan J.

Muller, "Focus On OpenView A Guide to Hewlett-Packard's Network and System Management

Platform". Referred to as **HP** in view of common knowledge of writing to different partitions on

a disk.

NOTE: Assignee's (HP) trademark OPENVIEW, first in commercial use February 15, 1989.

Registration number 1723609.

NOTE: The HP OpenView product teaches much more functionality than the instant invention.

The product has the capabilities to serve the role of a installer for a assembly line such as the HP

Pavillion line of PCs.

Claim 1

HP OpenView teaches a method for performing software installation into a computing system,

comprising the following steps:

(a) partitioning storage media of the computing system into a first partition and a second

partition;

(b) installing software bundles into the second partition, each software bundle being stored in

form as an image; and,

(c) installing bootable software and a user interface into the first partition, the bootable software

and the user interface, when run, being able to receive from a user a selection as to which of the

software bundles, to install in the computing system, and then install a software bundle selected

by the user into the first partition while overwriting the bootable software and the user interface.

Examiner's Response

HP OpenView is a software distribution product for sale and for use by HP that permits the

installation of software (Page 1, OpenView Framework Overview – second and last bullets CM

and SM). The ability to install bundled software is on page (179-182) and a User Interface is

covered on page 272. HP does not explicitly teach the exact partitions to load the software on.

However, partioned storage devices are old and well known and one of ordinary skill in the art

would have known how to copy to a target (such as a partition/directories) . In view of the 112

rejection above the User Interface is unclear.

Claim 2

A method as in claim 1 wherein in step (c) after installation of the software bundle selected by

the user, the bootable software erases the installation software bundles in the second partition.

Examiner's Response

Page 180 – 181 Distribution Depots to Target System.

Claim 3

A method as in claim 1 wherein in step (c) after installation of the software bundle selected by

the user, the bootable software erases the installation software bundles in the second partition by

overwriting the second partition with a file system.

Examiner's Response

Page 182 Software Management allows for install and removal.

Claim 4

A method for performing software installation into computing systems comprising the following

steps:

(a) transferring software to be installed from a software provider to a manufacturer, including the

following sub steps:

(a. 1) transferring operating system software in image-based format, and

(a.2) transferring hardware specific software in file-based format; and,

(b) installing the software, by the manufacturer, into the computing systems.

Examiner's Response

As per claim 1

Claim 5

A method as in claim 4 wherein step (b) includes the following sub steps:

(b. 1) installing the operating system software into the computing systems using image-based

format data transfer; and,

(b.2) installing the hardware specific software into the computing systems using file-based

format data transfer.

Examiner's Response

Page 104 – 108 the hardware such as routers etc are inventoried and updated.

Claim 6

A method as in claim 4 wherein in sub step (a. 1), application software is included in an image

that includes the operating system software.

Examiner's Response

As per claim 2.

Claim 7

A method as in claim 4 wherein in sub step (a.2), application software is transferred along with the hardware specific software.

Examiner's Response

As per claim 1.

Claim 8

A method as in claim 4: wherein in sub step (a. 1), multiple operating system software bundles are transferred; and, wherein in step (b), the manufacturer selects one of the multiple operating system software bundles to install into each computing system.

Examiner's Response

As per claim 1.

7.   Claims 12 – 13 are rejected under 35 U.S.C. 102(b) as being anticipated by DELL USPN #6,080,207.

Claim 12

DELL anticipates a computing system comprising: storage media partitioned into a first - partition and a second partition; wherein the second partition contains, installation software bundles, each installation software bundle being stored in form, as an image; and, wherein the first partition contains bootable software and a user interface, the bootable software and the user interface, when run, being able to receive from a user a selection as to which of the installation software bundles to install in the computing system, and then installing an installation software bundle selected by the user into the first partition while overwriting the bootable software and the user interface.

Examiner's Response

Dell col 1 10 – 36 disclose installing and configuring software both existing and upgrades. It is

inherent to install different vendors software into different partitions/directories.

Claim 13

A computing system as in claim 12 wherein after installing the installation software bundle

selected by the user into the first partition, the installation software bundles in the second

partition are erased.

Examiner's Response

Dell discloses support information such as OS, registers, initialization information and

configuration initialization is destructive. Col 8 lines 10 – 35 teach upgrades to support function

to existing software.

8.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over DELL as

applied to claim 12 - 13 above, and further in view of DELL2 #6,470,446.

Claim 14

A computing system as in claim 12 wherein after installing the installation software bundle

selected by the user into the first partition, the bootable software erases the installation software

bundles in the second partition by overwriting the second partition with a file system.

Examiner's Response

DELL teaches installing software but Dell does not explicitly mention destructive writing the

machine. It is DELL2 who teaches installation for a bootable drive. Therefore, it would have

been obvious to one of ordinary skill in the art at the time of invention to combine DELL with

DELL2 because installing machines that can boot makes machines useful.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 15 – 16 are rejected under 35 U.S.C. 102(e) as being anticipated by DELL USPN #6,470,446.

Claim 15

A computer implemented method for automating software installation, comprising the following step: (a) upon starting the computing system, running bootable software and a user interface stored within a first partition of storage, the bootable software and a user interface directing the computing system to perform the following sub steps:

(a. 1) giving a user an opportunity to select for installation into the computing system, one from a plurality of software bundles to install in the

computing system, each of the software bundles being stored in form as an image, each image being stored within a second partition of storage,

(a,2) receiving a selection by the user; and,

(a.3) installing a software bundle selected by the user into the first partition while overwriting the bootable software and the user interface.

Examiner's Response

NOTE: Clarifying the issue of User Interface above is important to limitations in this claim.

DELL Abstract anticipates the steps of installing software in a partition and updating the track which destroys the original content.

Claim 16

A method as in claim 15 wherein. step (a) additionally comprises the following sub step:

(a.4) erasing the installation software bundles in the second partition.

Examiner's Response

Dell Abstract teaches the destructive operation.

10.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over DELL in view of

Common Knowledge of Programming..

Claim 17

A method as in claim 15 wherein step (a) additionally comprises the following sub step:

(a.4) erasing the installation software bundles in the second partition by overwriting the second

partition with a blank file system.

Examiner's Response

        DELL teaches the customizes the installation process by does not explicitly teach

performing a delete with a destructive write by an operation such as using a blank file.

Official Notice is taken that destructive writes are old and well known and one of ordinary skill

in the art at the time of invention would have known to write over a data area to destroy the

contents because writing is destructive.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

12.   Claims 18 – 19 and 9 - 11are rejected under 35 U.S.C. 102(b) as being anticipated by HP

OpenView.

Claim 18

HP anticipates a computer implemented method for automating software installation, comprising

the following step:

(a) upon starting the computing system, running bootable software and a user interface stored

within a storage location, the bootable software and a user interface directing the computing

system to perform the following sub steps:

(a. 1) giving a user an opportunity to select for installation into the computing system, one from a

plurality of software bundles to install in the computing system, each of the software bundles

being stored in form as an image,

(a.2) receiving a selection by the user; and,

(a.3) installing a software bundle selected by the user into the computing system.

Examiner's Response

HP OpenView is a software distribution product for sale and for use by HP that permits the user

to install software (Page 1, OpenView Framework Overview – second and last bullets CM and

SM). The ability to install bundled software is on page (179-182) and a User Interface is covered

on page 272. HP does not explicitly teach the exact partitions to load the software on. However,

partioned storage devices are old and well known and one of ordinary skill in the art would have

known how to copy to a target (such as a partition/directories).

Claim 19

A method as in claim 18 wherein step (a) the storage location is a compact disc read only

memory (CD-ROM).

Examiner's Response

HP page 180 Distribution Overview CD-ROM.

Claim 9

HP anticipates a method for performing software installation into computing systems comprising

the following steps:

(a) transferring software to be installed from a software provider to a manufacturer, including the

following sub steps:

(a. 1) transferring multiple operating system software bundles, each multiple operating system

software bundle being in image-based format, and

(a.2) transferring multiple hardware specific software bundles;

(b) selecting, by the manufacturer, which of the multiple operating system bundles and which of

the hardware specific software bundles to install into each computing system; and,

(c) installing, by the manufacturer, into the computing systems, software bundles selected in step

Examiner's Response

Page 180 – 181 Distribution Overview and Distribution Depots - determines OS compatibility

and checks machine attributes.

Claim 10

A method as in claim 9 wherein in sub step (a.2) the multiple hardware specific software bundles

are transferred in file-based format.

Examiner's Response

Page 104 – 108 the hardware such as routers etc are inventoried and updated.

Claim 11

A method as in claim 9: wherein step (a) additionally comprises the following sub step:

(a.3) transferring multiple application software bundles; and, wherein step (b) includes selecting,

by the manufacturer, which of the multiple application software bundles to install into each

computing system.

Examiner's Response

Page 180 – 181 Distribution Overview and Distribution Depots.

Claim Rejections - 35 USC § 103

13.   Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over HP OpenView

in view of the choice of an optical drive - medium.

Claim 20

A method as in claim 18 wherein step (a) the storage location is a digital video disc (DVD).

Examiner's Response

HP teaches a software distribution system that writes to an optical disk system, page 180

Distribution Overview CD-ROM is explicitly mentioned. On page 175 figure 8-4 shows an

optical Disk Library. HP does not explicitly teach the optical disk to be a DVD. One of ordinary

skill in the art at the time of invention would understand an optical disk can included a DVD.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention

to write to a DVD, because optical disk can be read many times.

Examiner's Comments

14.   HP OpenView has many capabilities. It might be best for Applicant to claim a

methodology as opposed to ability for an installation process. This is intended to focus on steps

that are unique to the HP factory process.

Correspondence Information

15.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to **Todd Ingberg** whose telephone number is (703) 305-9775. The

examiner can normally be reached during the following hours:

Monday	Tuesday	Wednesday	Thursday	Friday
6:15 – 1:30	6:15- 3:45	6:15 – 4:45	6:15-3:45	6:15-130

This schedule began December 1, 2003 and is subject to change.
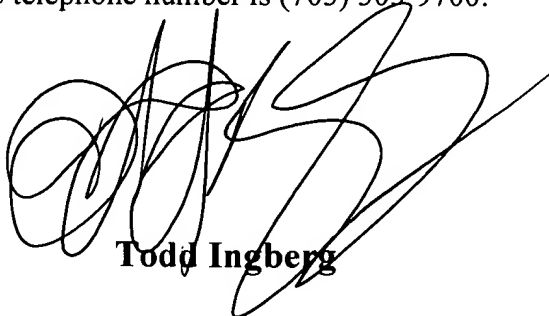
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, **Kakali Chaki** can be reached on (703) 305-9662. Please, note that as of August 4,

2003 the **FAX number** changed for the organization where this application or proceeding is

assigned is **(703) 872-9306**.

Also, be advised the United States Patent Office **new address** is

Post Office Box 1450

Alexandria, Virginia 22313-1450

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-9700.

Todd Ingberg

Primary Examiner
Art Unit 2124
February 8, 2004

Requirement For Information(RFI)

1.   An issue of public use or on sale activity has been raised in this application. In order for

the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b),

additional information regarding this issue is required as follows: The Assignee Hewlett Packard

(HP) has submitted an Information Disclosure Statement on their competitor Gateway but the

actual operations of HP have gone undisclosed. The HP Pavilion a product line of Personal

Computers (PC) has been in existence since at least the mid 1990's. An email from HP Instant

Support from February 16, 2002 indicates HP had the ability to distribute bundled software (e.g.

operating system . . . etc) and provide a hidden partition for recovery. *The scope of the RFI* is

the date of first use and first sale of Assignee's "HP Windows XP Recovery System" which is

preloaded on the hard drive in a hidden partition on the hard drive.

Where applicant does not have or cannot have readily obtained items of required

information, a statement that the item is unknown or cannot be readily obtained will be accepted

as a complete response to the requirement for that item. Applicant's response is binding on

Applicant(s), Assignee and Applicant's Representative.

The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents

submitted in reply to this requirement. This waiver extends only to those documents within the

scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first

complete communication responding to this requirement. Any supplemental replies subsequent

to the first communications responding to this requirement and any information disclosures

beyond the scope of this requirement under 37 ' C.F.R. 1.105 are subject to the fee and

certification requirement of 37 ' C.F.R. 1.97

This requirement is subject to the provisions of 37 C.F.R. 1.134, 1.135 and 1.136 and has

a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE

GRANTED UNDER 37 CFR 1.136(a).

Applicant is reminded that failure to fully reply to this requirement for information will

result in a holding of abandonment.

Correspondence Information

2.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to **Todd Ingberg** whose telephone number is (703) 305-9775. The

examiner can normally be reached during the following hours:

Monday	Tuesday	Wednesday	Thursday	Friday
6:15 – 1:30	6:15- 3:45	6:15 – 4:45	6:15-3:45	6:15-130

This schedule began December 1, 2003 and is subject to change.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, **Kakali Chaki** can be reached on (703) 305-9662. Please, note that as of August 4,

2003 the **FAX number** changed for the organization where this application or proceeding is

assigned is **(703) 872-9306**.

Also, be advised the United States Patent Office **new address** is
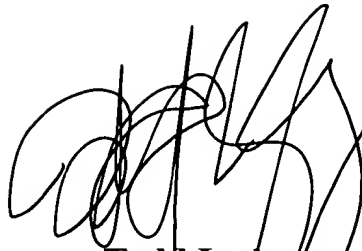
Post Office Box 1450

Alexandria, Virginia 22313-1450

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-9700.

Todd Ingberg
Primary Examiner
Art Unit 2124
February 8, 2004

KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100